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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,009	03/16/2001	Jean-Marc Ascione	05725.0634-00	5103

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EXAMINER


ELHILO, EISA B

ART UNIT PAPER NUMBER

1751

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/809,009	Applicant(s) ASCIONE ET AL.	
	Examiner Eisa B Elhilo	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1 A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/11/2004 has been entered.

### *Claim Rejections - 35 USC § 103*

2 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over de la Mettrie et al. (US' 5,989,295) in view of (XP-000934522).

De la Mettrie (US' 295) teaches an aqueous hair dyeing composition comprising anionic amphiphilic polymers containing at least one hydrophilic unit of unsaturated olefinic carboxylic acid and at least one hydrophobic unit which is a C10-C30 alkyl ester of unsaturated carboxylic selected from those hydrophilic unit of unsaturated olefinic carboxylic acid corresponds to the monomer of the formula (I) in which R1 denotes H, CH3 or C2H5 that is to say acrylic acid, methacrylic acid or ethacrylic acid units and in which the hydrophobic unit of C10-C30 alkyl ester of unsaturated carboxylic acid corresponds to the formula (II) in which R1 denotes H, CH3 or C2H5 that is to say acrylate, methacrylate or ethacrylate units and R2 denotes a C10-C30 alkyl radical C10-C30 alkyl ester of unsaturated carboxylic acids such as lauryl acrylate, stearyl

Art Unit: 1751

acrylate, decyl acrylate lauryl methacrylate or stearyl methacrylate (Pemulen TR1), as claimed in claims 1-6 and 8 (see col. 3, lines 50-67, formula I, col. 4, lines 1-20 and formula II and col. 10, Example 1), wherein the anionic polymer in the amount range from 0.05 to 10% by weight relative to the total weight of the dye composition which overlapped with the claimed percentage range as claimed in claim 15 (see col. 5, line 5), oxidizing agents such as hydrogen peroxide solution in the amount of 2.5 to 40 volumes which overlapped with the claimed percentage range as claimed in claims 17-19 (see col. 9, lines 52-55), wherein the composition further comprises other adjuvant such as anionic, nonionic or amphoteric surfactants as claimed in claim 20 (see col. 9, lines 30-31), wherein the composition is an aqueous solution as claimed in claim 21 (see col. 9, lines 10-11). De la Mettrie also teaches a method for dyeing hair which comprises the steps of applying to hair the composition as described above wherein the method is similar to the claimed methods as claimed in claims 22-63 (see col. 10, lines 15-24). de la Mettrie further, teaches a multi-compartment kit for treatment of keratinous fibers wherein the kit is similar to the claimed kit as claimed in claims 64-65 (see col. 3, lines 16-43).

Although de la Mettire et al. (US' 295) teaches a composition comprising at least one anionic associative polymer comprising at least one carboxylic group and at least one ester derived from a fatty alcohol and carboxylic acid as described above, the reference does not teach the additional anionic associative polymer that comprises at least one carboxylic acid group and at least one ester derived from an alkoxylated fatty alcohol and a carboxylic acid as claimed.

However, the primary reference teaches and suggests a number of anionic associative polymers having a mixture of monomers that can be used in the composition (see col. 4, lines 25-65).

(XP'522) teaches in analogous art of cosmetic formulation, an anionic associative polymer comprising at least one carboxylic acid group and at least one ester derived from an alkoxylated fatty alcohol and a carboxylic acid such as Acrylates/Methacrylates/ Beheneth-25 Methacrylate Copolymer (Aculyn 28) as claimed which is used as a thickener in hair dyes (see page 1, 5<sup>th</sup> paragraph), wherein the percentage amount of the polymer is 3.72% which within the claimed range as claimed (see page 2, 2<sup>nd</sup> paragraph).

Therefore, in view of teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would have been motivated to modify the composition of the primary reference by incorporating the Acrylates/Methacrylates/ Beheneth-25 Methacrylate Copolymer (Aculyn 28), as an additional anionic associative polymer that comprises at least one carboxylic acid group and at least one ester derived from an alkoxylated fatty alcohol and a carboxylic acid as taught by (XP' 522) to make such a composition with a reasonable expectation of success. Such modification would have been obvious because the primary reference of de la Mettrie et al. (US' 295), teaches and suggests a number of anionic associative polymers having a mixture of monomers that can be used in the composition (see col. 4, lines 25-65). (XP' 522) as a secondary reference clearly suggests the use of Acrylates/Methacrylates/ Beheneth-25 Methacrylate Copolymer in cosmetic formulation to offer thickening, stabilizing and the suspension of ingredients in the composition (see page 1, 5<sup>th</sup> paragraph), and, thus, a person of the ordinary skill in the art would be motivated to add this polymer in the hair treating composition for improving thickening, stabilizing and suspension of the composition and would expect such a composition to have similar properties to those claimed, absent unexpected results.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over de la Mettrie et al. (US' 5,989,295) in view of (XP-000934522) and further in view of Hutchins et al. (US 5,830,447).

The disclosures of de la Mettrie (US' 295) and (XP-522) are summarized above. The references fail to teach compositions comprising anionic associative polymer, which is crosslinked with at least one allyl ether chosen from allyl ethers of sucrose and allyl ether of pentaerythritol as claimed. However, the references teach compositions comprising similar anionic polymers that used as thickeners in cosmetic compositions as disclosed above.

Hutchins et al. (US' 447) in analogous art of hair treating formulation, teaches a composition comprising copolymers of C10-C30 alkyl acrylates with one or more of acrylic acid, methacrylic acid or one of their short chain (i.e. C1-4 alcohol) ester, wherein the crosslinking agent is an allyl ether of sucrose or pentaerythritol as claimed (see col. 23, lines 12-24).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would have been motivated to modify the composition of the primary reference by incorporating the anionic associative polymer, which is crosslinked with allyl ether of sucrose or pentaerythritol as taught by Hutchins et al. (US' 447) to make such a composition with a reasonable expectation of success. Such modification would be obvious because de La Mettire et al. (US' 295) as a primary reference clearly teaches and suggests the use of anionic associative polymers in a hair treating composition. Hutchins et al. (US' 447) as a secondary reference clearly teaches the use of anionic associative polymers in a hair treating composition wherein the polymers are structurally similar to those claimed, and, thus, a person of an ordinary skill in the art would expect that the use of such polymer as taught by Hutchins et

Art Unit: 1751

al. (US' 447) would be similarly useful and applicable to the analogous composition taught by de la Mettire (US' 295). Further, the similarities in chemical structure between the prior art and the claimed compounds and which have similar utilities establishes a prima facie case of obviousness. (In re Payne, 203VSPQ 245).

***Response to Applicant's Arguments***

3 Applicant's arguments filed 4/11/2004 have been fully considered but they are not persuasive.

With respect to the rejection based upon de la Mettire (US' 295) in view of Research disclosure, Applicant argues that the primary reference of de la Mettire et al. (US' 295), teaches away from the use of traditional thickeners that can impede the rise of the dye on the fibers, which is reflected in a dull shade and therefore, one of ordinary skill in the art would be cautioned against simply adding other thickeners in view of de la Mettire's teaching that traditional thickeners can results in an interior coloring.

The examiner respectfully disagrees with the above argument because the primary reference of de La Mettire (US' 295) clearly teaches and defines that the traditional thickeners are those belong to crosslinked polyacrylic acid, hydroxyethylcelluloses, waxes or alternatively mixtures of nonionioc surfactants with an HLB (hydrophilic-lipophilic balance) (see col. 1, lines 39-42) and none of the above described traditional thickeners is belong to the copolymers that taught by the secondary reference of (XP-522). Further, the secondary reference of (XP 522) clearly teaches and suggests the use of Acrylates/Methacrylates/ Beheneth-25 Methacrylate Copolymer (Aculyn 28) in cosmetic formulation to offer thickening, stabilizing and the suspension of ingredients in the composition (see page 1, 5<sup>th</sup> paragraph) and wherein the

Art Unit: 1751

copolymer (Aculyn 28) is used in other hair care products such as shampoos, conditioners, gels and scalp treatment (see page 1, 4<sup>th</sup> paragraph). Therefore, there is a sufficient motivation to one having ordinary skill in the art to incorporate the copolymer as taught by (XP 522) in the hair treating composition of de la Mettire (US' 295) with a reasonable expectation of success for improving the thickening and stabilizing the composition.

With respect to the applicant's argument on pages 3-4 and regarding the comparative data presented in the specification on pages 12-14, which the applicant rely on to show unexpected results such as acceptable physical stability over the composition of the prior art, has been fully considered but is not found persuasive because the comparative data in the Table in the specification on page 13 recited acrylates/C10-30 alkyl acrylate crosspolymer as the only example of using anionic associative polymer comprising at least one carboxylic acid group and at least one ester derived from a fatty alcohol and a carboxylic acid and acrylates/beheneth-25 methyacrylate copolymer or acrylate steareth-20 methylacrylate copolymer as the only example of additional anionic associative polymer comprising at least one carboxylic acid group and at least one ester derived from an alkoxylated fatty alcohol and carboxylic acid among many claimed as a large genus of anionic associative polymers including the species of acrylates/C10-30 alkyl acrylate crosspolymer as an anionic associative polymer and acrylates/beheneth-25 methyacrylate copolymer or acrylate steareth-20 methylacrylate copolymer as additional anionic associative polymer. Therefore, the data presented by the applicant is not commensurate in scope with the claimed invention that described anionic associative polymers that comprises unlimited number of species of anionic polymers. Applicant is directed to M.P.E.P 716.02(d) and (e) for the requirements of comparisons which will overcome a prima facie case of obviousness.



Art Unit: 1751

Objective evidence of unobvious results must be commensurate in scope with the claims. *In re Prater*, 162 USPQ 541; *In re Tiffin*, 172 USPQ 292; *In re Linder*, 172 USPQ 356; *In re Greenfield*, 197 USPQ 227. Where unobvious results are relied upon as a basis for patentability, a proper comparative showing is a minimum requirement. *In re Eisenhut*, 114 USPQ 287.


The argument based upon the rejection of claim 7 under 35 U.S.C. 103(a) over de La Mettire et al. (US' 295), Research disclosure, and de la Mettire 195, is rendered moot in view of the new ground of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Eisa Elhilo  
Patent Examiner  
Art Unit 1751

July 26, 2004